

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BRADLEY STEVEN RESCH, JOSEPH MICHAEL ZUKOWSKI,
MARGARET ANN O'DONOGHUE, and SHANE CHRISTIAN SMITH

Appeal 2007-2714
Application 10/090,517
Technology Center 1600

Decided: November 27, 2007

Before DONALD E. ADAMS, ERIC B. GRIMES, and NANCY J. LINCK,
Administrative Patent Judges.

GRIMES, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a topical personal care composition. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

BACKGROUND

The Specification states that “one of the most popular preservative classes currently used in personal care products is the class of preservatives known as parabens (parahydroxybenzoic acid esters)” (Specification 3). The Specification also states that “[p]arabens are popular because they have a wide spectrum of anti-microbial activity and have few global regulatory restrictions for use” and that “[m]ost products that contain parabens contain a combination of different chain length esters and/or enhancers such as phenoxyethanol or benzyl alcohol” (*id.*).

The Specification also states that “[i]t has surprisingly been discovered that retinoids may rapidly degrade when used in personal care compositions containing parabens” and “there is a continuing need to formulate personal care compositions having improved stability” (*id.*).

DISCUSSION

1. CLAIMS

Claims 1-12, 14-24, and 26 are pending and on appeal. The claims have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). We will focus on claim 1, the broadest claim on appeal, which reads as follows:

1. A topical personal care composition having improved stability of a retinoid, comprising:
 - a) a retinoid;

b) a preservative selected from the group consisting of phenols, phenol salts, quaternium ammonium compounds, halogens, halogen salts, alcohols, inorganic salts, zinc pyrithione, emulsifying preservatives, and mixtures thereof; and

c) a dermatologically acceptable carrier;

d) wherein the composition is substantially free of parahydroxybenzoic acid esters.

2. OBVIOUSNESS

Claims 1-12, 14-24, and 26 stand rejected under 35 U.S.C. § 103(a) as obvious in view of Yanagida¹, Oblong² and Bissett³. The Examiner relies on Yanagida as disclosing stable cosmetic compositions having vitamin A stabilized by a stabilizer that can be a phenol, vitamin E, vitamin C, or salicylic acid (Answer 3). The Examiner further relies on Yanagida for disclosing that the compositions may further comprise other well-known cosmetic ingredients (*id.*). The Examiner finds that Yanagida does not expressly teach the exclusion of parahydroxybenzoic acid esters, but that Yanagida's claims and examples do not require their presence (*id.* at 3-4).

The Examiner relies on Oblong as disclosing that synthetic or natural vitamin analogs, such as retinol esters, e.g., retinyl propionate, are well known in the art for use as vitamin A in cosmetic compositions (*id.* at 4). The Examiner relies on Bissett as disclosing that preservatives such as O-phenylphenol and dehydroacetic acid are well-known preservatives for cosmetic compositions, particularly those that comprise vitamin A (*id.*).

The Examiner concludes that it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the invention was made, to make a vitamin A-containing cosmetic composition without using parahydroxybenzoic acid esters because they are not required in Yanagida's compositions and use of another well-known preservative would have been obvious because of its known utility (*id.*).

We conclude that the Examiner has set forth a *prima facie* case that claim 1 would have been obvious to the ordinary artisan. In fact, we find

¹ Yanagida, US 6,024,941, Feb. 15, 2000

² Oblong, US 5,939,082, Aug. 17, 1999

³ Bissett, US 5,821,237, Oct. 13, 1998

that Yanagida anticipates claim 1. Yanagida describes a cosmetic oil formulation of vitamin A with the following ingredients: vitamin A; disodium edetate; hyaluronic acid; water; glycerol tri 2-ethylhexanoate triglyceride; isopropyl myristate; squalane; dipropylene glycol; ethanol; and POE(10) oleyl ether (*id.* at col. 11, lines 16-37 (Table 1-1, Example 1-1)). This composition contains Vitamin A (i.e., a retinoid), ethanol (i.e., a preservative that is an alcohol), and a dermatologically acceptable carrier (i.e., water), and the composition does not include parahydroxybenzoic acid esters. Therefore, Yanagida's composition reasonably appears to meet all of the limitations of claim 1.

Appellants argue that the cited prior art fails to teach or suggest all the claim limitations of the present invention because all of the cited references teach compositions containing parahydroxybenzoic acid esters (Appeal Br. 5-6). Appellants further argue that the cited prior art teaches away from the claimed invention because all of the references exemplify the use of parahydroxybenzoic acid esters (*id.* at 4). Finally, Appellants argue that they have found that parahydroxybenzoic acid esters contribute significantly to retinoid instability, and that since all of the references teach the use of these compounds, one of skill in the art could have not reasonable expectation of success to produce the claimed composition (*id.*)

We are not persuaded by these arguments. As set forth above, Yanagida exemplifies a composition (Example 1-1 in Table 1-1) that meets all of the limitations of claim 1. Anticipation is the epitome of obviousness. *See, e.g., Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983); *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982); *In re Pearson*, 494 F.2d 1399, 1402 (CCPA 1974). Thus, given that the claim is anticipated

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by Yanagida, we conclude claim 1 would have been obvious in view of the combination of Yanagida, Oblong and Bissett.

SUMMARY

The Examiner's position is supported by a preponderance of the evidence of record. We therefore affirm the rejection of claims 1-12, 14-24, and 26 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

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